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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/286,530	04/05/1999	L. LAWRENCE CHAPOY	7651/1239	5116

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EXAMINER

PREBILIC, PAUL B

ART UNIT	PAPER NUMBER
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3738

DATE MAILED: 11/22/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/286,530

Applicant(s)

CHAPOY ET AL.

Examiner

Paul B. Prebilio

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 August 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-17,19-22,24-40 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) 24-39 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-17,19-22,40 and 42-53 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

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### ***Election/Restrictions***

Claims 24-39 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 6 filed October 23, 2000.

### ***Claim Objection***

Claims 1, 16, and 40 are objected to because of the following informalities:

In claims 1, 16, and 40, lines 6, 7, or 10, the language "from one polymeric material" conflicts with "and combinations thereof" on the last line of each claim. Rather, there should be the language "at least" after "from" in order to overcome this objection and make it clear combinations of the materials can be used. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-14, 40, 42, and 44-53 rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al (US 6,158,862) in view of Patel (US 5,252,262). Patel et al discloses a monolithically produced intraocular lens with haptics, but fails to disclose a coating on at least the distal portions of the haptics as claimed. However, Patel ('262) teaches that it was known to coat haptics on similar intraocular lenses with polyimide in

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order prevent dye or pigment leakage; see the whole document, especially Figures 26-27 and column 4, lines 15-57. Hence, it is the Examiner's position that it would have been obvious to clear coat at least the haptics of Patel et al in order to prevent dye leakage which is a concern to Patel et al as well; see column 4, lines 7-14.

With regard to claims 2, 9-14 and 44-53, the product-by-process steps are only given weight to the extent that they affect the final product with little burden on the Examiner's part to meet the claim language; see MPEP 2113, which is incorporated herein by reference thereto. Hence, it is the Examiner's position that the claim product-by-process limitations result in an identical, or alternatively, a substantially identical product to that disclosed by Patel et al as modified by Patel such that the claims are clearly unpatentable thereover.

With regard to claim 6, HEMA is synonymous with 2-hydroxyethylmethacrylate such that the claim language is fully met.

With regard to claim 8, the 550 nm or 400 nm wavelength range is within the UV radiation range, and thus, the dye of Patel et al is a UV absorbing compound to the extent required by the claims; see Patel et al on column 4, lines 1-29.

With regard to claim 40 and 42-53, the polyimide as claimed is the same material as that set forth by Patel, such that it would inherently have the same fibrosis promotion affect.

Claims 15-17, 19-22, and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Patel et al and Patel ('262) as applied to claims 1, 2, 4-14, 40, 42, and 44-53 above, and further in view of Cumming (US 5,047,051). Patel et al meets the

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claim language except for the footplate or an opposing set of plates with grooves as claimed. Cumming, however, teaches that it was known to make haptics into opposing plate or footplate forms with grooves; see the figures and the rest of the document. Hence, it is the Examiner's position that it would have been obvious to make the polyimide coated haptics of Patel et al as modified by Patel into a plate form and to coat the entire haptics thereof with polyamide for the same reasons that Cumming forms his haptics into that form.

### ***Response to Arguments***

Applicant's arguments filed August 29, 2002 have been fully considered but they are not persuasive.

In traversing the Polar et al in view of Polar rejection, Applicant argues that the claim language "monolithically produced" (actually the claims use the terminology "monolithically formed") is not met because the prior art contains no equivalent phrase. However, the Examiner notes that the terminology "monolithically formed" is a product-by-process limitation. For this reason, it is only given weight to the extent it implies certain structure is present in the final product; see MPEP 2113 which is incorporated herein by reference thereto. Therefore, since Figure 2 of Patel shows a continuous one-piece lens and haptic structure, the Examiner asserts that the limitation "monolithically produced" is fully met.

Furthermore, as stated in MPEP 2113, the Examiner is under a lesser burden of proof to show product-by-process limitations are met because of their peculiar nature.

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In response to the argument about Patel et al not having a coating on the distal portions of the haptic, the Examiner notes that Patel et al was not used to show this feature and that was what the secondary reference, Patel, was used to show was obvious.

Applicant argues that neither Patel et al nor Patel discuss anything pertaining to fibrosis promotion effects. However, the rejection uses a different motivation for the combination. The reason for the coating in Patel need not be the same as that of Applicant's invention in order for the claims to be considered obvious thereover; see MPEP 2144 which is incorporated herein by reference thereto and see *In re Linter* 173 USPQ 560 (CCPA 1972).

Next, Applicant argues that Patel, the secondary reference, does not show a monolithically produced intraocular lens. The Examiner notes that Patel was not used to teach this feature that was already shown in the primary reference to Patel et al. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### **Conclusion**

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Applicant should specifically point out the support for any amendments made to the disclosure, including the claims (MPEP 714.02 and 2163.06). Due to the procedure outlined in MPEP 2163.06 for interpreting claims, it is noted that other art may be applicable under 35 USC 102 or 35 USC 103(a) once the aforementioned issue(s) is/are addressed.

Applicant is respectfully requested to provide a list of all copending applications that set forth similar subject matter to the present claims. A copy of such copending claims is respectfully requested in response to this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Prebilic whose telephone number is (703) 308-2905. The examiner can normally be reached on Monday-Thursday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on (703) 308-2111. The fax phone number for this Technology Center is (703) 872-9301.

Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 3700 receptionist whose telephone number is (703) 308-0858.



Paul Prebilic  
Primary Examiner  
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